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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05793.3050-00000

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on _____

Signature _____

Typed or printed name _____

Application Number

09/827,247

Filed

April 6, 2001

First Named Inventor

Ronald L. TARDIF

Art Unit

3691

Examiner

D. Kesack

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☐

attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 46,508

Beth Z. Palys Reg No. 56,921
Signature

Joseph E. Palys

Typed or printed name

571-203-2713

Telephone number

February 16, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 form is submitted.

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RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 3622
Customer No. 22,852
Attorney Docket No. 05793.3050

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Ronald L. TARDIF) Group Art Unit: 3691
Application No.: 09/827,247) Examiner: Daniel Kesack
Filed: April 6, 2001) Confirmation No.: 7207
For: CREDIT CARD DRIVER'S) Mail Stop AF
LICENSE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the Final Office Action dated November 16, 2006. This request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicant may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicant concurrently files the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicant submits a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005.

Applicant has met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Rejections Under 35 U.S.C. § 103(a) Are Legally Deficient Because the Examiner Incorrectly Asserts that Certain Claim Recitations are Intended Use

A. The Examiner Inappropriately Asserts Intended Use and Unreasonably Interprets Claim Terms Contrary to Guidelines Established in M.P.E.P. § 2111

In the Final Office Action (hereinafter, “Final OA”) mailed November 16, 2006, the Examiner rejected pending claims 4-17, 21-29, and 33-47 under 35 U.S.C. § 103(a). In support of these rejections, the Examiner states “that the recitation of the application source being a driver’s license issuing site, and of the first fund source being the central driver’s license issuing site, as well as the recitation that card is created by a ‘government identification issuing entity’ . . . is regarded as intended use, and is generally not given weight for patentability.” See Final OA, pages 4 and 5. However, these claim terms are not recitations of intended use and the Examiner’s interpretation of them as such is unreasonable.

Although the Examiner is entitled to interpret the claims terms broadly, such interpretation cannot be unreasonable. Indeed, M.P.E.P. § 2111 indicates that “pending claims must be given their broadest reasonable interpretation consistent with the specification.” While the Examiner may not be required to “interpret claims in applications in the same manner as a court would interpret claims in an infringement suit,” the Examiner is required to apply “to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” M.P.E.P. § 2111. Accordingly, the broadest reasonable interpretation of the “driver’s license issuing site,” “central driver’s licensing issuing site,” and “government identification issuing entity,” as recited in the pending claims, must be consistent with the interpretation of the phrases that those skilled in the art would reach. *See Id.*

Here, as noted above, the Examiner incorrectly asserts that “driver’s license issuing site,” “central driver’s licensing issuing site,” and “government identification issuing entity,” are “regarded as intended use.” Final OA, pages 4 and 5. These assertions are not consistent with the interpretation of the terms as is known in the art and in the context of Applicant’s specification. Ignoring reasonable interpretations of claim terms, in the context of not only the specification, but the known meaning in the art violates at least the policies governed by the M.P.E.P. and fails to support the rejection of claims 4-17, 21-29, and 33-47 in view of the cited art. Therefore, for the

reasons stated above, the rejections of claims 4-17, 21-29, and 33-47 under 35 U.S.C. § 103(a) are legally deficient, should be withdrawn, and the claims allowed.

B. The Examiner Has Failed to Properly Examine Applicant's Claims

While Applicant disagrees with the Examiner's characterization of the aforementioned claim recitations as intended use, the Examiner's analysis of the patentable weight to be given to intended use recitations is nevertheless flawed. "The subject matter of a properly construed claim is defined by the terms that limit its scope." M.P.E.P. § 2106(II)(C). "As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope." *Id.* Also, while statements of intended use may raise a question as to limiting effect of the language in a claim, they must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. MPEP § 2111.02(II). Indeed, the Examiner is required to demonstrate how the prior art structure is capable of performing the intended use. M.P.E.P. § 7.37.09

Indeed, none of the cited prior art teaches or suggests systems, methods, or computer-readable mediums including instructions "for obtaining a credit card driver's license" or "of processing requests for a credit card driver's license," as recited in Applicant's pending claims. Instead, U.S. Patent No. 5,774,882 to Keen teaches an automated security credit checking system for checking a credit application for fraud before a credit card is issued. U.S. Patent No. 5,878,403 to DeFrancisco et al. teaches an automated credit application analysis and decision routing system and, in the exemplary embodiments, describes its use between a bank and an automotive dealership. The article entitled "Welfare Credit Cards Set For Use, Southwest Michigan Begins Using Cards This Week," by Adam Jackson teaches the use of "welfare credit cards" in lieu of food stamps and welfare checks. While U.S. Patent No. 6,224,109 to Yang ("Yang") teaches a credit card with driver's license, Yang discloses the structure and design of a credit card with driver's license "for providing credit to an individual, information regarding the individual and proof of registration to operate a motor vehicle on a single form of identification (Abstract)." Thus, none of the cited art teaches or suggests systems, methods, or computer-readable mediums including instructions "for obtaining a credit card driver's license" or "of processing requests for a credit card driver's license,"

as required by guidance found in the M.P.E.P. Indeed, the cited art is incapable of use “for obtaining a credit card driver’s license” or “of processing requests for a credit card driver’s license.”

Failing to properly analyze the claim terminology, in the context of not only the specification, but the known meaning in the art, violates at least the policies governed by the M.P.E.P. and fails to support the rejection of claims 4-17, 21-29, and 33-47 in view of the cited art. Therefore, for the reasons stated above, the rejections of claims 4-17, 21-29, and 33-47 under 35 U.S.C. § 103(a) are legally deficient, should be withdrawn, and the claims allowed.

III. The Rejections Under 35 U.S.C. § 103(a) Are Legally Deficient Because the Examiner Incorrectly Asserts that Certain Claim Recitations are Non-Functional Descriptive Material

The Examiner states that “nonfunctional descriptive material cannot render non-obvious an invention that would have otherwise been obvious.” Final OA, page 5. However, the Examiner incorrectly asserts that “the location of the card issuing entity, and the identity of the credit validation entities are regarded as descriptive material” and that “[t]he location of the processing equipment, and the locations where requests are accepted, and responses are returned, does not functionally change the system, and therefore these limitations do not distinguish the invention from the prior art.” *Id.* Whether or not the claim recitations “functionally change the system” is not the proper test for determining whether nonfunctional descriptive material is to be given patentable weight. M.P.E.P. § 2106.01. Rather, it is the presence of a functional interrelationship among the claim recitations that must be evaluated. *Id.*

First, a determination of nonfunctional descriptive matter requires that the claim terms be reasonably interpreted. According to the M.P.E.P., “[n]on functional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.” M.P.E.P. § 2106.01. Again, although the Examiner is entitled to interpret terms broadly, the interpretation must be reasonable. M.P.E.P. § 2111. In this case, the Examiner’s interpretation of claim recitations including “driver’s license issuing site,” “central driver’s licensing issuing site,” and “government identification issuing entity” as nonfunctional descriptive material is not consistent with the interpretation of the terms as is known in the art and in the context of Applicant’s specification.

Further, even if the aforementioned claim recitations were considered nonfunctional descriptive material, which Applicant disputes, there are sufficient functional interrelationships to imbue patentable weight. For example, Applicant's claim 4 recites, *inter alia*, "receiving a request from an applicant to obtain a credit card driver's license product, wherein the request is received by a local driver's license issuing site," "generating, by the local driver's license issuing site, a credit validation request . . . ," "forwarding the credit validation request to a central driver's licensing issuing site," and "determining whether the central driver's license issuing site is capable of processing the forwarded credit validation request" (emphasis added). Applicant's independent claim 4 further recites "if it is determined that the central driver's license issuing site is not capable of processing the credit validation request, transmitting the credit validation request to a credit card issuer," and "if it is determined that the central driver's license issuing site is capable of processing the credit validation request, transmitting a response from the central driver's license issuing site to the local driver's license issuing site" (emphasis added).

Again, failing to properly analyze the claim terminology in the context of not only the specification, but the known meaning in the art at the time of Applicant's invention, violates at least the policies governed by the M.P.E.P. and fails to support the rejection of claims 4-17, 21-29, and 33-47 in view of the cited art. Therefore, for the reasons stated above, the rejections of claims 4-17, 21-29, and 33-47 under 35 U.S.C. § 103(a) are legally deficient, should be withdrawn, and the claims allowed.

IV. Conclusion

In view of the foregoing remarks, the Final Office Action includes legal deficiencies with regard to the rejection under 35 U.S.C. § 103(a). As such, Applicant respectfully requests that the rejection of these claims be reconsidered and withdrawn, and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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for Joseph E. Palys
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Dated: February 16, 2007